



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/912,079	07/24/2001	Todd R. Collart	70696	3412

22887 7590 10/30/2003

DISCOVISION ASSOCIATES
INTELLECTUAL PROPERTY DEVELOPMENT
2355 MAIN STREET, SUITE 200
IRVINE, CA 92614

EXAMINER

MCCLELLAN, JAMES S

ART UNIT	PAPER NUMBER
----------	--------------

3627

DATE MAILED: 10/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/912,079

Applicant(s)

COLLART, TODD R.

Examiner

James S McClellan

Art Unit

3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 July 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 8,9,11,&
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Information Disclosure Statement

1. Applicant's submission of IDS (papers 8, 9, 11, and 12) have been considered and a signed copy of each PTO-1449 is included with this Office Action.

Claim Objections

2. Claim 3 is objected to because of the following informalities: line 3, "to" should be deleted. Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. Claims 13 and 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 13 and 14 recite the limitation "the video" in lines 5 & 6 (claim 13) and lines 3 & 4 (claim 14). There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

Art Unit: 3627

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-5, and 14 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S.

Patent No. 6,035,329 (Mages et al.).

Regarding **claim 1**, Mages et al. discloses a method for tracking usage of a recording medium based on an identifier stored on the recording medium, the method comprising the steps of: receiving from a client device an indicia (see column 2, lines 46-51) corresponding to the identifier of the recording medium upon the recording medium being input into the client device by a user; receiving from the client device an indicia identifying the client device (see column 4 lines 4-19); determining a characteristic of the storage medium based on the received indicia corresponding to the identifier (see column 3, lines 27-31); identifying the client device based upon the received indicia identifying the client device (it is inherent that the client device has an identification number because the client device is in communication with a service provider over the Internet); and storing the characteristic of the recording medium and the identity of the client device in a database (see column 3, lines 45-55); [**claim 2**] the characteristic of the recording medium includes an intended usage (see column 3, lines 27-31, requiring or not requiring pay-per-view); [**claim 3**] the characteristic of the recording medium includes whether the recording medium was intended for rental (pay-per-view) or retail sale (not pay-per-view); [**claim 4**] utilizing the client device to read the identifier (see column 4, lines 4-19); and transmitting indicia corresponding to the identifier from the client device to a server via the Internet utilizing a browser embodied on the client device (see column 3, lines 45-55); [**claim 5**] determining a

Art Unit: 3627

manner in which the recording medium is being used by the client device based on the determined client identity and recording medium characteristic (see column 3, lines 27-31; requiring or not requiring pay-per-view); and **[claim 14]** the determined characteristic of the recording medium is that the recording medium has been stolen, the method further comprising the step of disallowing play of the recording medium based upon the determination that the recording medium has been stolen (see column 4, lines 33-41).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 6, 12, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mages et al. in view of U.S. Patent No. 4,658,093 (Hellman).

Regarding **claims 6, 12, and 13**, Mages et al. fails to explicitly disclose the step of monitoring a database to determine whether a recording medium is being operated on multiple devices; allowing play only an identified client device; and monitoring the number of times the recording medium has played and disallowing play of the recording medium after the recording medium has been played a predetermined number of times.

Hellman teaches the steps of monitoring a database to determine whether a recording medium is being operated on multiple devices; allowing play only an identified client device (see Abstract, lines 11-14, "base unit specific"); and monitoring the number of times the recording

Art Unit: 3627

medium has played and disallowing play of the recording medium after the recording medium has been played a predetermined number of times (see column 4, lines 21-26).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Mages et al. with the recording medium monitoring features taught by Hellman, because monitoring the use of a recording medium helps reduce software piracy (see Hellman, Abstract).

9. Claims 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mages et al. in view of U.S. Patent No. 6,332,126 (Peirce et al.).

Regarding **claims 7-9**, Mages et al. fails to explicitly disclose identifying the merchant from whom the user obtained the recording medium and transmitting marketing information.

Peirce et al. teaches the use of disclose identifying the merchant from whom the user obtained the recording medium and transmitting marketing information (see column 2, lines 15-66).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Mages et al. with merchant monitoring of Peirce et al., because monitoring merchant information increases the data associated with the user's purchasing history and will improve marketing for potential merchants.

10. Claims 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mages et al. in view of U.S. Patent No. 6,260,758 (Blumberg).

Regarding **claims 10 and 11**, Mages et al. fails to explicitly disclose affinity programs that include issuing random prizes and offering coupons.

Art Unit: 3627

Blumberg teaches the use of affinity programs that include issuing random prizes and offering coupons (see paragraph bridging columns 5-6).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Mages et al. with the affinity programs taught by Blumberg, because affinity programs increase the customers loyalty to the merchant.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure.

Grube et al. is cited of interest for disclosing a method for monitoring and limiting distribution of data.

Russo is cited of interest for disclosing a stored program pay-per-view.

Herz et al. is cited of interest for disclosing a method for scheduling broadcast of and access to video programs and other data using customer profiles.

Um et al. is cited of interest for disclosing a method for controlling remote reproduction of an information-stored medium in a reproduction apparatus.

Hastings et al. is cited of interest for disclosing a method for renting items.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jim McClellan whose telephone number is (703) 305-0212. The examiner can normally be reached on Monday-Friday from 9:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski, can be reached at (703) 308-5183.

Art Unit: 3627

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

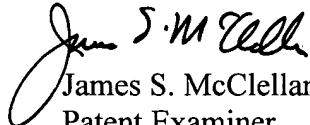
Any response to this action should be mailed to:

Commissioner of Patent and Trademarks
Washington D.C. 20231

or faxed to:

(703) 305-7687 (Official communications) or
(703) 746-3516 (Informal/Draft communications).

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive,
Arlington, VA, 7th floor receptionist.


James S. McClellan
Patent Examiner
A.U. 3627

jsm
January 21, 2002